

REMARKS/ARGUMENTS

The Examiner is thanked for the Official Action dated February 28, 2006. This amendment and request for reconsideration is intended to be fully responsive thereto.

Claims 1-25 were rejected under 35 U.S.C. 103 as being unpatentable over Kometani in view of Peng. Applicant respectfully disagrees.

Regarding claim 1: The Examiner concedes that Kometani fails to disclose a seal of substantially solid thermoplastic material. In fact, the seal portion 220 of Kometani is made of non-woven fabric and is unitary with the pleated filter.

Claim 1 recites the seal formed on the corner portion of the filter media. Contrary to the present invention, the seal portion 220 of Kometani is provided along the outer periphery of the circular connecting portion 210 that completely encompasses the filter portion 100 (see column 4, lines 5-11). In other words, Kometani fails to disclose the seal formed on the corner portion of the filter media. Thus, even if the combination of and modification of Kometani and Peng suggested by the Examiner could be made, the resulting filter element still would lack the seal formed on the corner portion of the filter media.

The Examiner also concedes that Kometani fails to disclose a seal of substantially solid thermoplastic material. In fact, the seal portion of Kometani is made of non-woven fabric and is unitary with the pleated filter.

Moreover, Applicant remains of opinion that Peng, directed to a roofing member, is completely non-analogous art. In other words, the reference to Peng is neither in the field of

applicant's endeavor nor reasonably pertinent. Clearly, Peng that discloses the roofing membrane (Class 442: FABRIC (WOVEN, KNITTED, OR NONWOVEN TEXTILE OR CLOTH, ETC.) is not analogous to the claimed invention that recites the filter element having a seal of substantially solid thermoplastic material (Class 55: GAS SEPARATION). Although Peng mentions the gaskets made of thermoplastic material, MPEP 2141.01(a) specifically requires that in order to rely on a reference as a basis for rejection of an applicant's invention under 35 U.S.C. 103, the reference must be in the field of applicant's endeavor or be reasonably pertinent. Clearly, the reference to Peng as a whole (directed to the roofing member) is not reasonably pertinent to the particular problem with which the inventor was concerned (filter element with seal of substantially solid thermoplastic material). Thus, for this reason alone, the rejection of claim 1 under 35 U.S.C. 103(a) over Kometani and Peng is improper.

Furthermore, the filter portion and the seal portion of Kometani are made of the same nonwoven fabric of chemical fiber. Accordingly, if the combination of and modification of Kometani and Peng suggested by the Examiner could be made, then not only the seal portion of Kometani should be made of TPV, but also the filter portion. However, that is impossible as the TPV material cannot function as a filter media.

For this reason alone the teachings of Kometani and Peng cannot be combined, as the prior art provides no suggestion and/or motivation to do so. Moreover, the Examiner has failed to present the necessary motivation to combine the teachings of Peng with that of Kometani. Clearly the Examiner has attempted to reconstruct Applicants invention with the benefit of hindsight as the art of roofing material in no way relates or pertains to filter elements and filter media. Thus, any rejection of claims 1-5 under 35 U.S.C. 103 is improper.

Regarding claim 6: In addition to the above arguments regarding the patentability of claim 1, Kometani fails to disclose the seal including a contact portion having a free portion engaging the filter housing or the lid thereof whereby a bending moment is introduced into the contact portion upon closing the lid. Thus, any rejection of claims 6-18 under 35 U.S.C. 103 is improper.

Regarding claim 19: As argued above, the teachings of Kometani and Peng cannot be combined, as the prior art provides no suggestion and/or motivation to do so. First, the filter portion and the seal portion of Kometani are made of the same nonwoven fabric of chemical fiber. Accordingly, if the combination of and modification of Kometani and Peng suggested by the Examiner could be made, then not only the seal portion of Kometani should be made of TPV, but also the filter portion. Moreover, Peng, directed to a roofing member, is completely non-analogous art.

Furthermore, none of the references cited by the Examiner discloses the step of injecting a seal around a face of the filter media while the filter media is in the injection molding machine to form a filter element.

Thus, any rejection of claims 19-22 under 35 U.S.C. 103 is improper.

Regarding claim 23: claim 23 has been amended to correct minor informalities. No new matter has been added.

In addition to the above arguments regarding the patentability of claim 19, Kometani fails to disclose the steps of injecting molten material for a hard frame member around the face

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of the filter media, and injecting a seal on the hard frame member while the filter media is in the injection molding machine to form a filter element.

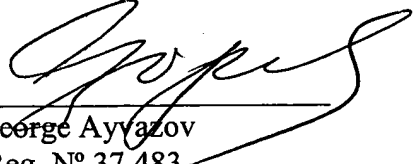
Thus, any rejection of claims 23-25 under 35 U.S.C. 103 is improper.

The Examiner further noted that claims 1, 3, 5, 6, 8-10 and 12-18 of the present application conflict with claims 1, 4, 5, 7-9 and 11-16 of co-pending Application No. 10 /404,109. While applicant respectfully disagrees, the rejection is acknowledged. Being that no claim has been allowed, the cost to file a terminal disclaimer is premature. Upon indication of an allowable claim, applicant will file a terminal disclaimer mooting the rejection and advancing prosecution to allowance.

It is respectfully submitted that claims 1-25 define the invention over the prior art of record and are in condition for allowance, and notice to that effect is earnestly solicited. Should the Examiner believe further discussion regarding the above claim language would expedite prosecution they are invited to contact the undersigned at the number listed below.

Respectfully submitted:

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